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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER NELSON, FREDA ANN				
ART UNIT 3628		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/701,850

**Applicant(s)**

MAXWELL, MARCUS A.

**Examiner**

FREDA NELSON

**Art Unit**

3628

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on October 2, 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☒ Claim(s) 4, 8, and 21-22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The amendment received on October 2, 2008 is acknowledged and entered.. No claims have been added. Claims 1-22 are currently pending.

#### ***Response to Amendment and Arguments***

Applicant's arguments filed October 2, 2008 have been fully considered but they are not persuasive.

1. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Fallon et al. discloses parts of the software application 70 can track information about the events that occur, to provide further information to a user and/or to the manufacturer(s) of the UPS 50 and/or the software application 70 ([0108]; and the events that are logged are used to generate information and reports about the performance of the UPS 50 and can be used for other aspects of the software application 70. Representative examples of events that can be logged include blackout, undervoltage, overvoltage, sensitivity fluctuation, self-test with result, worksafe condition, shutdown, hibernation, and online (the latter can be used to determine how long the UPS 50 was on battery due to a power event). FIG. 10 is an illustrative representative screen shot illustrating a performance summary report 400 based on events that the software application 70 logged over a time period ([0109]); and

However, ENERGYSTAR® discloses ENERGY STAR's CFO calculator takes a practical look at your energy situation and you can choose either (a) best estimates of how your building currently operates and how much better it *could* operate, or (b) data generated when you use ENERGY STAR's portfolio manager (see page 2).

2. In response to Applicant's argument that the cited combination does not disclose or suggest computing an estimate of cost savings for the UPS from the obtained historical power status information as recited in Claim 1, the Examiner respectfully disagrees. Fallon et al. discloses the events that are logged are used to generate information and reports about the performance of the UPS 50 and can be used for other aspects of the software application 70. Representative examples of events that can be logged include blackout, undervoltage, overvoltage, sensitivity fluctuation, self-test with result, worksafe condition, shutdown, hibernation, and online (the latter can be used to determine how long the UPS 50 was on battery due to a power event). FIG. 10 is an illustrative representative screen shot illustrating a performance summary report 400 based on events that the software application 70 logged over a time period ([0109]); and

### ***Claim Objections***

3. Claims 4, 8, and 21-22 are objected to because of the following informalities:

Claims 4 and 8 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 21 is incomplete.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 10 and 12-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 10 and 12-13 are written in "single means claim" format since they recite only one element to do all the functions recited. The claim is not written in "means-plus-function" language, however, in *Fiers v. Revel*, (CAFC) 25 USPQ2d 1601, 1606 (1/19/1993), the CAFC affirmed a rejection under 35 USC 112 of a claim reciting a single element that did not literally use "means-plus-function" language. Claims 10 and 12-13 are drawn to any "data processor", regardless of construct, that performs the function recited. This parallels the fact situation in *Fiers* wherein "a DNA" and a result was recited. The CAFC stated in *Fiers* at 1606, "Claiming all DNA's that achieve a result without defining what means will do so is not in compliance with the description requirement; it is an attempt to preempt the future before it has arrived." See also *Ex parte Maizel*, (BdPatApp&Int) 27 USPQ2d 1662, 1665 and *Ex parte Kung*,

(BdPatApp&Int) 17 USPQ2d 1545, 1547 (1/30/1989) wherein the claims at issue were rejected for being analogous to single means claims even though "means" was not literally used. Thus, claims 10 and 12-13 yield a "data processor" that achieves a result without defining what will do so.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 5, 8, 10, 12, 14-15, 18 and 21, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fallon et al. (US PG Pub. 2003/0132949), in view of "Cash flow, Energy performance, and Environmental Protection, What's the Link? ENERGYSTAR® (hereinafter referred to as "ENERGYSTAR®".

**As per Claims 1, 10, and 14**, Fallon discloses a method, calculator and computer program product that estimates a cost savings attributable to use of a backup power system, comprising the following steps implemented in a data processing system: obtaining historical power status information relating to operation of the backup power system (¶ [0016]-[0017];[0081];[0108]-[0109]; FIG. 10).

Fallon fails to disclose the computing the estimate of cost savings from the obtained historical power status information.

However, ENERGYSTAR® discloses ENERGY STAR's CFO calculator takes a practical look at your energy situation and you can choose either (a) best estimates of how your building currently operates and how much better it *could* operate, or (b) data generated when you use ENERGY STAR's portfolio manager (see page 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Fallon et al. to include the feature of "ENERGYSTAR®" in order to inform the user of a cost savings realized through the use of such a device since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**As per claims 2, 8, 12, 15 and 21**, Fallon further discloses wherein the received historical power status information comprises at least one of a number of power failures and a duration of the power failures, wherein the power outage cost factor comprises a one-time cost factor for a single power failure and/or a cost per hour without power factor and wherein the user interface comprises a graphical user interface (GUI). (Figure 10).

**As per claims 5 and 18**, Fallon fails to disclose the method of claim 4 further comprising exporting the per incident savings estimate, the hourly savings estimate and/or the estimate of cost savings to a computer application. However, Eulau discloses

the exporting of the estimated data to a computer application. (Figure 1; Figure 19; Col. 2, lines 10-13; Col. 3, line 40 - Col. 4, line 10). Examiner interprets exporting to include the computation of data by a computer or Internet server and the sending of that data to another computer application (i.e. web browser).

**As per claims 6 and 19**, Fallon further discloses the method of Claim 4 further comprising displaying the one-time cost factor, the cost per hour factor, the number of power failures, the duration of the power failures, the per incident savings estimate, the hourly savings estimate and the estimate of cost savings on a graphical user interface (GUI) (Figure 10; 0009; 0016; 0017).

6. Claims 3-4, 7, 9, 11, 13, 16-17, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fallon et al. (US PG Pub. 2003/032949, in further view of "ENERGYSTAR®", still in further view of Eulau et al. (US Patent Number 6,411,910).

**As per claim 3 and 16**, Fallon fails to disclose the method of claim 2 further comprising: obtaining a one-time cost factor for a single power failure; and obtaining a cost per hour without power factor.

However, Eulau teaches the collection and generation of various data pertaining to the costs associated with a power loss. (Figures 5-19; Col. 2, lines 5-50; Col. 3, line 65 - Col. 4, line 10; Col. 5, line 55 - Col. 6, line 15) Examiner interprets the data collected in Eulau to include both the cost per hour and single incident cost because the



collection of data includes a wide range of values that can be used to accurately compute both of these values. In fact, cost per hour values are explicitly disclosed and the cost per incident value is merely a function of the cost per hour value. Further, Examiner interprets the total revenue and profit at risk generated by Eulau to be the same as the potential amount saved by a backup power supply. This is because the backup power supply eliminates power failures and reduces the risk to zero, thus recovering the total revenue and profit that was initially at risk.

Therefore, it would have been obvious to one of ordinary skill in the art to modify the invention of Fallon and Sneering to include the features of Eulau, because informing the user of a backup power supply of the cost savings realized through the use of such a device is an excellent means to justify the purchase and maintenance of a backup power supply and provide the user with additional data concerning the operation of their backup power supply.

**As per claims 4, 9, 13, 17, and 22**, Fallon shows the collection of data pertaining to power failure incidents and the duration of the power failures. Fallon further computes the total power failures and the total duration of power failures and displays these results to the user through a GUI. (Figure 10). Fallon fails to disclose calculating a per incident savings estimate based on the number of power failures and the one-time cost factor; calculating an hourly savings estimate based on the duration of the power failures and the cost per hour without power factor; and calculating the estimate of cost

savings associated With the backup power system based on the calculated per incident savings estimate and the calculated hourly savings estimate.

However, Eulau teaches the collection and generation of various data pertaining to the costs associated with a power loss. (Figures 5-19; Col. 2, lines 5-50; Col. 3, line 65 - Col. 4, line 10; Col. 5, line 55 - Col. 6, line 15). The Examiner interprets the data collected in Eulau to include both the cost per hour and single incident cost because the collection of data includes a wide range of values that can be used to accurately compute both of these values. Further, the Examiner interprets the total revenue and profit at risk generated by Eulau to be the same as the potential amount saved by a backup power supply. This is because a backup power supply abolishes power failures and reduces the risk to zero, thus recovering the total revenue and profit that was initially at risk.

Therefore, it would have been obvious to one of ordinary skill in the art to include the features of Eulau and "ENERGYSTAR®" in Fallon and multiply the values to calculate the total estimated cost savings, because informing the user of a backup power supply of the cost savings realized through the use of such a device is an excellent means to justify the purchase and maintenance of a backup power supply and provide the user with additional data concerning the operation of their backup power supply .

**As per claims 7 and 20**, Fallon discloses a method and computer program product that estimates the cost savings attributable to use of a backup power system,

the method comprising the following steps implemented on a data processing system: receiving historical power status information from a UPS over a communications link; (Figure 10; 0016; 0017; 0081; 0108; 0109) and displaying the estimate of cost savings on the user interface. (Figure 10; 0009; 0016; 0017).

Fallon fails to disclose accepting a power outage cost factor from a user interface and computing an estimate of cost savings based on the historical power status information and the power outage cost factor.

However, Eulau teaches the acceptance of a power outage cost factor from a user interface (Figure 13) and computing an estimate of cost savings based on the historical power status information and the power outage cost factor. (Figures 5-19; Col. 2, lines 5-50; Col. 3, line 65 - Col. 4, line 10; Col. 5, line 55 - Col. 6, line 15) Examiner interprets the data collected in Eulau to include both the cost per hour and single incident cost because the collection of data includes a wide range of values that can be used to accurately compute both of these values. Further, Examiner interprets the total revenue and profit at risk generated by Eulau to be the same as the potential amount saved by a backup power supply. This is because a backup power supply abolishes power failures and reduces the risk to zero, thus recovering the total revenue and profit that was initially at risk.

Therefore, it would have been obvious to one of ordinary skill in the art to include the features of Eulau and "ENERGYSTAR®" in Fallon and multiply the values to calculate the total estimated cost savings, because informing the user of a backup power supply of the cost savings realized through the use of such a device is an

excellent means to justify the purchase and maintenance of a backup power supply and provide the user with additional data concerning the operation of their backup power supply.

**As per Claim 11**, Fallon further discloses the calculator of claim 10 wherein the data processor is operatively associated with a graphical user interface (GUI) (Figure 10; 0009; 0016; 0017). Fallon fails to disclose wherein the GUI is configured to receive the historical power status information and transmit the historical power status information to the data processor.

However, Eualau teaches wherein the GUI is configured to receive the historical power status information and transmit the historical power status information to the data processor. (Figures 5-19; Col. 2, lines 5-50; Col. 3, line 65 - Col. 4, line 10; Col. 5, line 55 - Col. 6, line 15).

Therefore, it would have been obvious to one of ordinary skill in the art to combine the calculator and GUI disclosed in Fallon with features of "ENERGYSTAR®" and Eualau because informing the user of a backup power supply of the cost savings realized through the use of such a device is an excellent means to justify the purchase and maintenance of a backup power supply and provide the user with additional data concerning the operation of their backup power supply.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRED A. NELSON whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday and Wednesday-Friday, 8:30 AM -4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. A. N./  
Examiner, Art Unit 3628  
01/04/2009

/John W Hayes/  
Supervisory Patent Examiner, Art Unit 3628